

**IN THE DRAWINGS:**

Please replace sheets 1-6 of the drawings submitted herewith for the sheets of drawings corresponding to FIGS. 1, 2, 3, 4, 5, 6, 7, and 8 pending in the application.

**REMARKS**

**I. Status of the Claims**

The Office Action dated October 17, 2006 has been received and its contents carefully considered. Claims 1-3, 5, 8-14, 16, and 24-25 were rejected under 35 U.S.C. §103(a) as being unpatentable over Reed (U.S. Patent No. 5,513,787) in view of Malone (U.S. Patent No. 4,281,466). Claims 6-7, 17-21, 23 and 26 were rejected under 35 U.S.C. §103(a) as being unpatentable over the references as applied to claims 5, 11, 16 and 25, and further in view of Landa (U.S. Design Patent No. D468,097). Claims 4 and 15 were rejected under 35 U.S.C. §103(a) as being unpatentable over the references as applied to claims 3 and 14 and further in view of Galetta (U.S. Patent No. 4,514,915).

By this Reply, claims 1, 10, 20-22, and 24-25 have been amended; claims 12-13 have been canceled; and claims 27-28 have been added. Accordingly, claims 1-11 and 14-28 are pending in this application.

Reconsideration and withdrawal of the outstanding rejections are respectfully requested in view of the following remarks.

**II. Status of the Drawings**

In the Office Action, the drawings were objected to as failing to comply with 37 C.F.R. 1.83(a) for allegedly failing to:

- (1) show the method steps of inserting an article of footwear into the cavity and securing the article by closing the mechanism as claimed in claim 10;
- (2) show the step of sewing the peripheral edge as claimed in claim 12;
- (3) show the step of sewing the mechanism as claimed in claim 13.

Regarding issue (1), the replacement FIG. 5 illustrates the footwear 10 inserted within the cavity 56 of the shoe cover 30. The mechanism 42 is closed to secure the footwear 10 therein.

Regarding issues (2) and (3), claims 12 and 13, respectively, have been canceled. Hence, it is believed that the drawings are in compliance.

The drawings were also objected to as failing to comply with 37 C.F.R. 1.84(p)(5) because they allegedly did not include reference sign "40" mentioned in the description. However, upon further review, item 40 is shown in FIG. 2 as a back ankle area of the footwear storage cover 28. It is believed that the drawings as submitted herewith are in compliance.

### **III. Claim Rejections - 35 U.S.C. § 112**

Claim 22 was rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Claim 22 has been amended to recite "a carrying

strap". Hence, it is believe that proper antecedent basis is shown forth in the claims as amended.

#### **IV. Claim Rejections - 35 U.S.C. § 103**

For the reasons discussed on pages 4-5 of the Office Action, the Examiner rejected claims 1-3, 5, 8-14, 16, and 24-25 under 35 U.S.C. §103(a) as being unpatentable over Reed (U.S. Patent No. 5,513,787) in view of Malone (U.S. Patent No. 4,281,466). As discussed on page 5 of the Office Action, the Examiner rejected claims 6-7, 17-21, 23 and 26 under 35 U.S.C. §103(a) as being unpatentable over the references as applied to claims 5, 11, 16 and 25, and further in view of Landa (U.S. Design Patent No. D468,097). And, as discussed on page 5 of the Office Action, the Examiner rejected claims 4 and 15 under 35 U.S.C. §103(a) as being unpatentable over the references as applied to claims 3 and 14 and further in view of Galetta (U.S. Patent No. 4,514,915).

Reed, Malone, Landa, and Galetta, however, fail to render the claimed invention unpatentable. Each of the claims recite specific combinations of features that distinguish the invention from the prior art in different ways. For example, independent claim 1 recites a combination that includes, among other things:

a first unitary piece having a first unitary lower peripheral edge and a first unitary upper peripheral edge . . . a second unitary piece having an outer peripheral edge, wherein the outer peripheral edge is attached to the lower peripheral edge of the first unitary piece to form a cavity within the attached pieces . . . an opening and closing mechanism attached to the

upper peripheral edge of the first unitary piece, the mechanism being capable of closing to encapsulate the footwear within the cavity,

(claim 1, ll. 3-10). Moreover, independent claim 10 recites another combination that includes:

providing a first unitary piece having a first unitary lower peripheral edge and a first unitary upper peripheral edge . . . providing a second unitary piece having an outer peripheral edge . . . attaching the outer peripheral edge of the second unitary piece to the lower peripheral edge of the first unitary piece to generally form a cavity within the attached pieces . . . providing an opening and closing mechanism . . . placing the opening and closing mechanism over the cavity and attaching the mechanism to the upper peripheral edge of the first unitary piece . . . inserting an article of footwear into the cavity via the mechanism in an open position . . . securing the article of footwear by closing the mechanism to encapsulate the footwear within the cavity,

(claim 10, ll. 3-15). In addition, independent claim 24 recites yet another combination that includes:

means for encapsulating the footwear within a cavity, the encapsulating means including means for opening and closing the encapsulating means to gain access to said cavity . . . means for promoting luster to the footwear within said cavity,

(claim 24, ll. 9-14). At the very least, Reed, Malone, Landa, and Galetta, whether each taken alone or in combination, fail to disclose or suggest any of these exemplary features recited in the independent claims 1, 10, and 24.

The Examiner has failed to establish a *prima facie* case of obviousness for at least four reasons. First, the Examiner has not demonstrated how Reed, Malone, Landa, and Galetta, whether taken alone or in combination, disclose or suggest each and every feature recited in the claims. See M.P.E.P. § 2143 (7th ed. 1998). Second, the Examiner has not shown the existence of any reasonable probability of success in

modifying Reed, the base reference, based on the teachings of Malone, Landa, and Galetta, the secondary references, in a manner that could somehow result in the claimed invention. See *id.* Third, the Examiner has not identified any suggestion or motivation, either in the teachings of the applied references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify Malone in a manner that could somehow result in the claimed invention. See *id.* Finally, the Examiner has not explained how her obviousness rationale could be found in the prior art — rather than being a hindsight reconstruction of Applicants' own disclosure. See *id.*

Each of the Examiner's factual conclusions must be supported by "substantial evidence" in the documentary record, as required by the Federal Circuit. See *In re Lee*, 61 U.S.P.Q.2d 1430, 1435 (Fed. Cir. 2002). The Examiner has the burden of documenting all findings of fact necessary to support a conclusion of anticipation or obviousness "less the 'haze of so-called expertise' acquire insulation from accountability." *Id.* To satisfy this burden, the Examiner must specifically identify where support is found within the prior art to meet the requirements of 35 U.S.C. §§ 102(b) and 103. In this case, however, the Examiner has failed to satisfy his burden of demonstrating how Reed, taken alone or in combination with Malone, Landa, and Galetta, can either anticipate or render obvious each and every one of the limitations present in independent claims 1, 10, and 24 as required by the MPEP and Federal Circuit jurisprudence.

Reed discloses a shoe transport arrangement including a floor 19 from which a shoe upper 20 extends. A second floor 28 is hingedly mounted about a toe or forward end portion of the bag member about a hinge web portion 33, such as indicated in FIGS. 3 and 6. First and second connecting straps 24 and 25 are arranged for selective fastening to respective third and fourth connecting straps 26 and 27. Reed, however, fails to provide an disclosure of "a second unitary piece having an outer peripheral edge, wherein the outer peripheral edge is attached to the lower peripheral edge of the first unitary piece to form a cavity within the attached pieces . . . an opening and closing mechanism attached to the upper peripheral edge of the first unitary piece, the mechanism being capable of closing to encapsulate the footwear within the cavity," as stated in independent claim 1. Reed also fails to disclose "inserting an article of footwear into the cavity via the mechanism in an open position . . . securing the article of footwear by closing the mechanism to encapsulate the footwear within the cavity," as recited in independent claim 10. Furthermore, Reed fails to disclose at least a "means for encapsulating the footwear within a cavity," as recited in independent claim 24.

Instead, Reed teaches away from the claimed invention. For example, Reed does not utilize a unitary piece to form the shoe arrangement as recited in claims 1 and 10. The arrangement of Reed includes additional pieces, namely the toe or forward end portion of the bag member to connect the shoe upper 20 to the floor 19 or hinge web portion 33 (e.g., col. 2, ll. 54-56 and FIGS. 3 and 6). The use of such materials may increase production cost for producing the shoe arrangement. Having additional pieces

as disclosed, for example, by Reed may also make the integrity of the additional connecting seams susceptible to failure during use. Furthermore, Reed does not encapsulate the footwear as recited in claims 1, 10 and 24. At best, Reed merely retains the footwear within the entrance opening 21 via connecting straps 24, 25, 26 and 27. The footwear may remain sufficiently exposed in the arrangement of Reed. This may not sufficiently protect the footwear inserted therein from containments such as insects, dirt, and debris, for example. The arrangement of Reed may further lack the capability to promote luster of the footwear due to insufficient coverage. The claimed invention fully encapsulates the footwear and is further capable of promoting luster to the surface of the footwear such as via frictional contact of the unitary piece rubbing against the footwear surface.

Turning to the secondary references, Malone, Landa, and Galetta, all fail to remedy the deficiencies of Reed. For example, the Examiner relies upon Malone solely to allegedly disclose "the fastener." Office Action at page 5. The Examiner also relies upon Landa only to ostensibly disclose "hoops and rings to receive the carrying strap." *Id.* at page 5. Moreover, the Examiner relies upon Galetta merely to purportedly disclose "the zipper fastener such that it extends across the entire upper portion." *Id.* at page 5. None of the secondary references address the particulars of the claimed features which are found lacking in the Reed reference. Thus, modifying Reed with the teachings of Malone, Landa, and Galetta would fail to overcome the shortcomings found in the base reference.



Moreover, even if Reed could be properly modified to result in the claimed invention, which it could not, there is no motivation for modifying this reference in the manner suggested by the Examiner. One having ordinary skill in the art at the time of the invention would not even consider making the Examiner's imagined modifications because Reed explicitly teaches away from the claimed invention, as discussed above. Indeed, the Examiner's fictitious changes would impermissibly: (1) render Reed unsatisfactory for its intended purposes; and (2) change the principles of operation of the Reed method. The MPEP specifically states that if the "proposed modification would render the prior art unsatisfactory for its intended purpose" or "change a principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious." M.P.E.P. § 2143.01 at 112-13 (7th ed. 1998). Accordingly, it is only through hindsight afforded by Applicant's own disclosure that the Examiner can even assert that the applied references suggest the claimed invention. Such hindsight determinations are impermissible under 35 U.S.C. § 103.

For at least these reasons, Reed, as proposed to be repeatedly modified by the teachings of Malone, Landa, and Galetta all fail to disclose or render obvious each and every element recited in independent claims 1, 10, and 24.

Claims 2-9 depend from independent claim 1 and are patentable over the cited prior art for at least the same reasons as set forth above with respect to claim 1.

Claims 11, 14-23 and 28 depend directly or indirectly from independent claim 10 and are patentable over the cited prior art for at least the same reasons as set forth above with respect to claim 10.

Claims 25-27 depend directly or indirectly from independent claim 24 and are patentable over the cited prior art for at least the same reasons as set forth above with respect to claim 24.

In addition, each of these dependent claims also recite combinations that are separately patentable.

In view of the foregoing remarks, this claimed invention, as amended, is not rendered obvious in view of the prior art references cited against this application. Applicant therefore request the entry of this response, the Examiner's reconsideration and reexamination of the application, and the timely allowance of the pending claims.

The Office Action contains characterizations of the claims and the related art with which Applicant does not necessarily agree. Unless expressly noted otherwise, Applicant declines to subscribe to any statement or characterization in the Office Action.

In discussing the specification, claims, and drawings in this response, it is to be understood that Applicant in no way intends to limit the scope of the claims to any exemplary embodiments described in the specification and/or shown in the drawings. Rather, Applicant is entitled to have the claims interpreted broadly, to the maximum extent permitted by statute, regulation, and applicable case law.

Should the Examiner believe that a telephone conference would expedite issuance of the application, the Examiner is respectfully invited to telephone the undersigned inventor at (301) 336-2200 Ext. 221.

Respectfully submitted,

Dated: 02/15/07

By:   
Dr. David W. Gadson



Docket No.: MWB0001.02  
Inventor: Jonathan David GADSON et al.  
Serial No.: New U.S. Patent Application  
Filed: February 24, 2004  
Page 1 of 8

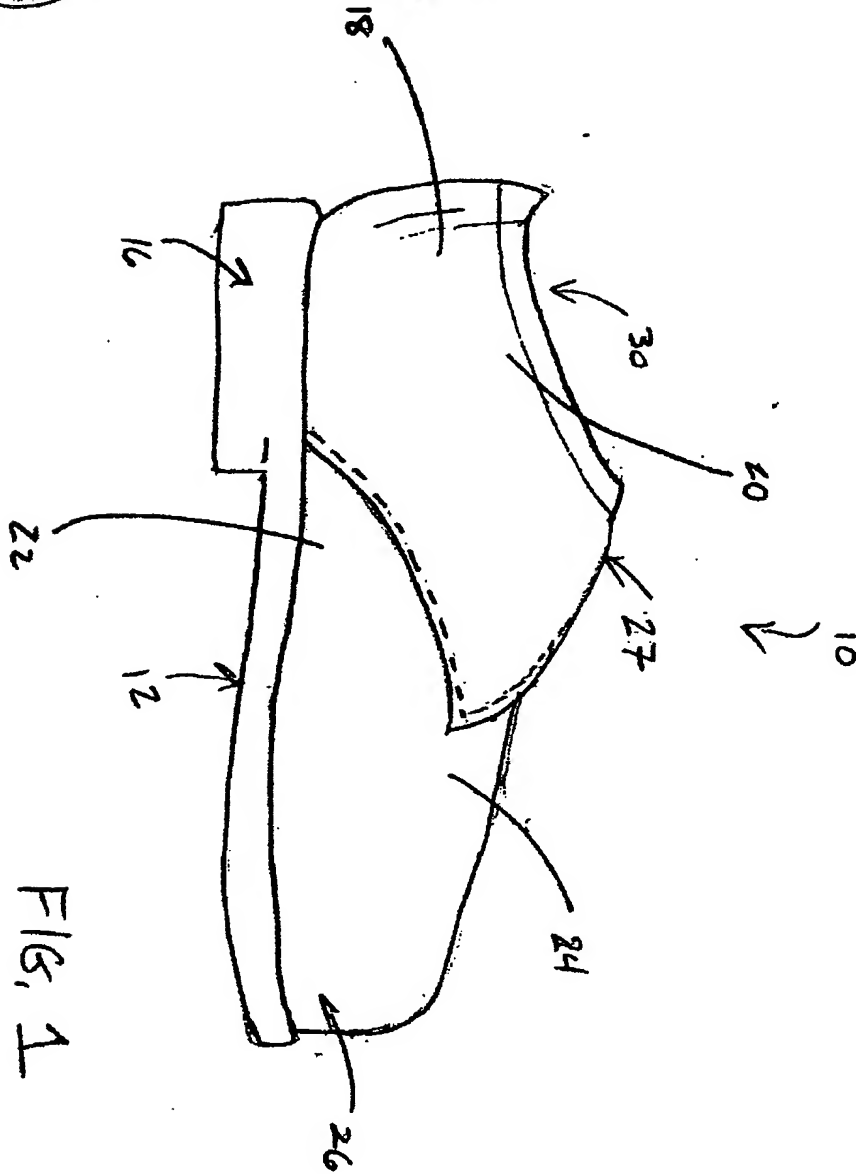


FIG. 1

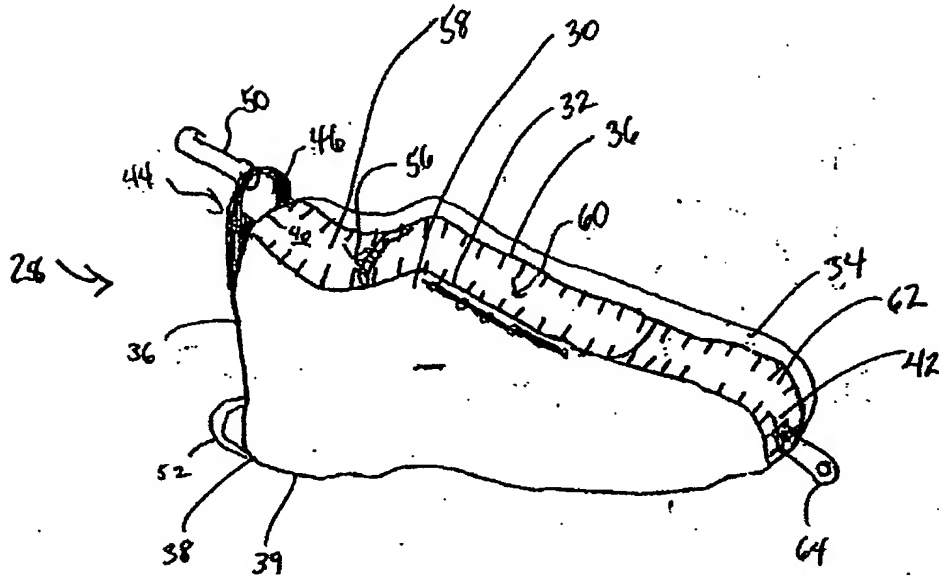


FIG. 2

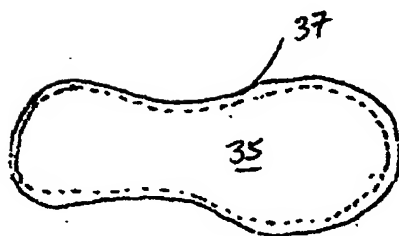


FIG. 3

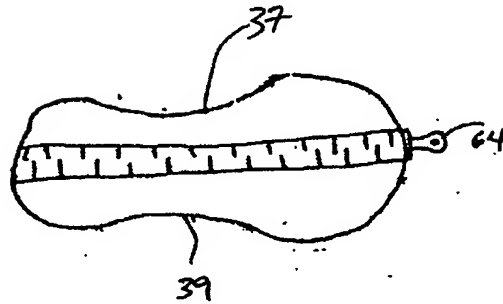


FIG. 4

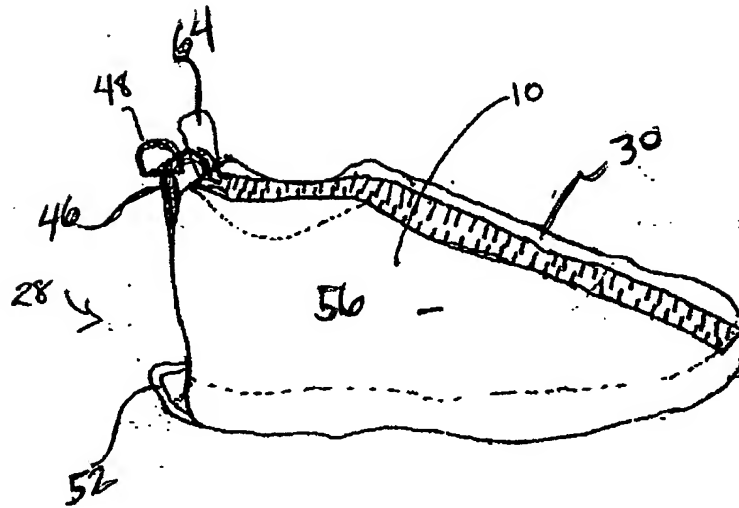


FIG. 5



Docket No.: MWB0001.02  
Inventor: Jonathan David GADSON et al.  
Serial No.: New U.S. Patent Application  
Filed: February 24, 2004  
Page 6 of 8

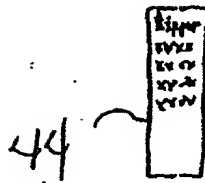


FIG. 6

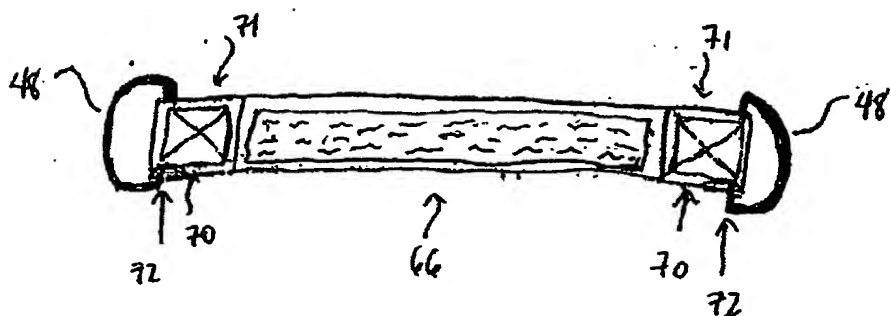


FIG. 7

Page 8 of 8

